

Appl. No. 10/558,719  
Response to Office Action of July 24, 2008

PATENT  
Docket No.: NL030649US1  
Customer No. 000024737

### REMARKS

By this amendment, the specification and claims 1-14 have been amended. New claim 15 has been added. Claims 1-15 remain in the application. Support for the amendments to the claims can be found in the specification and drawings. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, and allowance of the application, as amended, is respectfully requested.

The specification has been amended to correct for a minor typographical error. The claims have been amended to more clearly point out the novelty of the invention and to correct for other errors, such as antecedent basis and claim dependencies. New claim 15 has been added to provide for a more complete claim coverage.

### Rejection under 35 U.S.C. §103

Claim 1 recites an opto-electronic input device, wherein the input is formed by detected movements of an object (M), which input device is provided with an optical module comprising at least one laser with a resonant cavity for generating a measurement radiation beam (S), optical means for guiding the radiation beam (S) to a plate (V) close to the object (M), and conversion means for converting radiation from the measurement radiation beam (S), which is reflected by the object (M), into an electric signal, wherein the conversion means are formed by the combination of the resonant cavity of the laser and measurement means for measuring a change in the resonant cavity during operation, which change is caused by interference of the reflected radiation from the measurement radiation beam (S), which penetrates the resonant cavity, and the standing wave in the resonant cavity, and which is representative of a relative movement of the object (M) with respect to the module, wherein the optical module comprises the laser mounted on a carrier plate, and the optical means comprise an optical

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component mounted on the carrier plate and aligned with the laser, from which optical component the measurement radiation beam (S) emitted by the laser travels to the plate (V) close to the object (M), wherein the plate (V) comprises, close to the object (M), a first portion (V1) that comprises an upper surface of a transparent block-shaped body which is situated within a projection of the object (M), wherein the transparent block-shaped body (i) is configured to enable passage of the radiation beam (S) upon entering near a lower side and through multiple internal reflections against sidewalls of the transparent block-shaped body to the upper surface of the transparent block-shaped body and (ii) is situated in a fixed position with respect to the carrier plate in that the transparent block-shaped body is mounted onto the carrier plate, as well as a second portion (V2) which is situated within a projection of the object (M) and is movable in a direction perpendicular to the carrier plate, wherein the second portion (V2) comprises signaling means which, in response to movement of the second portion (V2) in the direction perpendicular to the carrier plate, is configured to issue a signal that can be perceived by a user of the device.

Support for the amendments to claim 1 (as well as for claim 14) can be found in the specification at least on page 3, lines 10-11, 15-19, 26-29, and 33-34; page 5, lines 32-34; page 7, lines 16-22; page 8, lines 18-19; and FIGs. 2 and 4.

Claims 1, 2, 4, 7-11, and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **Gordon et al.** (US 2002/0135565) in view of **Liess et al.** (US 2002/0104957). This rejection is also understood to include claims 12 and 14, in view of the examiner's comments on page 2 of the Office Action, at the beginning of the fourth paragraph (line 21). Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 1.

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As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following reasons.

**1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

The **Gordon** and **Liess** references cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

*A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ...*  
(Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Gordon** nor **Liess** teaches an opto-electronic device featuring "... a plate (V) comprising ... a first portion (V1) that comprises an *upper surface* of a transparent block-shaped body ... wherein the *transparent block-shaped body* (i) is configured to enable passage of the radiation beam (S) upon entering near a *lower side* and through *multiple internal reflections* against sidewalls of the transparent block-shaped body to the upper surface of the transparent block-shaped body and (ii) is situated in a fixed position with respect to the carrier plate ... mounted onto the carrier plate, ... [and] ... a second portion (V2) ...

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movable in a direction perpendicular to the carrier plate, wherein the *second portion* (V2) comprises *signaling means* which, in response to movement of the second portion (V2) in the direction perpendicular to the carrier plate, is *configured to issue a signal* that can be perceived by a user of the device" as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

In contrast, **Liess** discloses use optical fibres, such as optical fibres 72, 73 and 74 as shown in the illustration of (FIG. 11a) and discussed in paragraph [0115] of **Liess**. The illumination beams are guided to a window of the input device by the optical fibres. The window of **Liess** does not teach or suggest "... a plate (V) comprising ... a first portion (V1) that comprises an *upper surface* of a transparent block-shaped body ... wherein the *transparent block-shaped body* (i) is configured to enable passage of the radiation beam (S) upon entering ... a *lower side* and through *multiple internal reflections* against sidewalls of the transparent block-shaped body to the upper surface of the transparent block-shaped body and (ii) is situated in a fixed position with respect to the carrier plate ... mounted onto the carrier plate, ... [and] ... a second portion (V2) ... movable in a direction perpendicular to the carrier plate, wherein the *second portion* (V2) comprises *signaling means* which, in response to movement of the second portion (V2) in the direction perpendicular to the carrier plate, is *configured to issue a signal* that can be perceived by a user of the device" as is claimed in claim 1.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

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## 2. The Combination of References is Improper

Even assuming, *arguendo*, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still yet another compelling reason why the **Gordon** and **Liess** references cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

*...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, neither **Gordon** nor **Liess** teaches, or even suggests, the desirability of the combination since neither teaches the specific opto-electronic device featuring "... a plate (V) comprising ... a first portion (V1) that comprises an *upper surface* of a transparent block-shaped body ... wherein the *transparent block-shaped body* (i) is configured to enable passage of the radiation beam (S) upon entering near a *lower side* and through *multiple internal reflections* against sidewalls of the transparent block-shaped body to the upper surface of the transparent block-shaped body and (ii) is situated in a fixed position with respect to the carrier plate ... mounted onto the carrier plate, ... *[and]* ... a second portion (V2) ... movable in a direction perpendicular to the carrier plate, wherein the *second portion* (V2) comprises *signaling means* which, in response to movement of the second portion (V2) in the direction perpendicular to the carrier plate, is *configured to issue a signal* that can be perceived by a user of the device" as specified above and as claimed in claim 1.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the

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art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination as suggested by the office action arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Dependent claims 2, 4, and 7-13 depend from and further limit independent claim 1 and therefore are allowable as well.

Independent claim 14 has been amended herein to include limitations similar to those of claim 1. Accordingly, claim 14 is believed allowable for at least the same reasons as presented herein above with respect to overcoming the rejection of claim 1, and an early formal notice thereof is requested.

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Claims 3 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over **Gordon et al.** in view of **Liess et al.**, in further view of **Niederdrank** (US 7174026). Applicant respectfully traverses this rejection for at least the following reason. Dependent claims 3 and 5 depend from and further limit independent claim 1 and therefore are allowable as well.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over **Gordon et al.** in view of **Liess et al.**, in further view of **Niederdrank**, in further view of **Jones et al.** (US 2004/0137929). Applicant respectfully traverses this rejection for at least the following reason. Dependent claim 6 depends from and further limits independent claim 1 and therefore is allowable as well.

#### **New Claim**

New claim 15 has been added to provide for more complete claim coverage of the embodiments of the present application. Claim 15 depends from and further limits dependent claim 8 which depends from allowable independent claim 1 and therefore is allowable as well.

#### **Conclusion**

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is respectfully submitted from all of the foregoing that independent claims 1 and 14 are in condition for allowance. Dependent claims 2-13 depend from and further

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limit independent claim 1 and therefore is allowable as well. New claim 15, which depends from independent claim 1, is believed in condition for allowance, also.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 1-15 is requested.

Respectfully submitted,



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